



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/711,851	10/08/2004	Reinhard Berger	LUKP:126US	5850

24041 7590 06/07/2005

SIMPSON & SIMPSON, PLLC
5555 MAIN STREET
WILLIAMSVILLE, NY 14221-5406

EXAMINER

LEWIS, TISHA D

ART UNIT	PAPER NUMBER
----------	--------------

3681

DATE MAILED: 06/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/711,851

Applicant(s)

BERGER ET AL.

Examiner

TISHA D. LEWIS

Art Unit

3681

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 11-15 and 19-24 is/are rejected.
- 7) ☒ Claim(s) 9, 10 and 16-18 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

The following is a first action on the merits of application serial no. 10/711,851 filed on October 8, 2004.

Priority

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Germany on April 10 and August 24, 2002. It is noted, however, that applicant has not filed a certified copy of the German applications as required by 35 U.S.C. 119(b).

Also applicant should provide a copy of either the search report or preliminary examination of the PCT from which this application claims domestic priority from.

Information Disclosure Statement

The information disclosure statement filed on February 28, 2005 has been acknowledged.

Claim Objections

Claims 10, 21, 23 and 24 are objected to because of the following informalities:

- In claim 10, line 2, --of-- should be inserted between "revolutions" and "the".
- In claim 21, line 2, --of-- should be inserted between "revolutions" and "the".
- In claims 23 and 24, "described in" should be changed to --according to--.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 3681

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1, 5, 6, 8, 11-15, 19, 20 and 22-24 are rejected under 35 U.S.C. 102(a) as being unpatentable by DE 10228709A1(US 20040157704). Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

DE discloses a motor vehicle having an electric motor (70) as a starter and arranged between an engine clutch (74), a gearbox clutch (4), a drive unit (2), a clutch gearbox (6) and a power take off shaft wherein the gearbox clutch is slowly engaged during engine starting and due to the slow engaging, the engine (2) is disconnected from the power take off shaft until the clutch (4) is fully engaged. The engine is started according to a measured vehicle acceleration (via 24) different from a previous acceleration of the vehicle driven by the electric motor. The engine is started according to a high speed driving required outside the electric motor speed parameters. The engine speed and a clutch torque transmitting value are determined (via 18, [0009], [0016]) according to predetermined values. The engine is started according to a high speed value and temperature [0091] determined by a control device that also holds parameters for the engine, gearbox and clutch.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3681

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 4 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over DE in view of Hohn ('602). DE discloses an acceleration control, but does not disclose fuel/gas controlled by the controller to start the engine.

Hohn discloses a drive assembly wherein an electric machine is used to start an engine while a kickdown switch is turned on and an extreme acceleration is determined (gas pedal exceeds position, high fuel consumption) (column 2, lines 31-39).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the engine of DE started with a kickdown switch turned on in view of Hohn to reduce the speed output of the engine to provide smooth transformation between the electric motor drive mode to the engine drive mode.

Claims 1, 2, 14, 15, 19, 20 and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over DE 19917665A1 (US 6,705,416) in view of Boll ('470). Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

DE discloses a motor vehicle having an electrical machine (4) arranged between an engine clutch (7), a gearbox clutch (8), a drive unit (2), a clutch gearbox (3) and a power take off shaft (5) wherein the machine (4) is used to start the engine (2) with a

Art Unit: 3681

slipping of the clutch (7) according to a speed value and temperature factor determined by a controller, but does not disclose the gearbox clutch slipping.

Boll discloses a motor vehicle having an electrical machine (EM2) arranged between an engine clutch (10), a gearbox clutch (24), a drive unit (4), a clutch gearbox (26) and a power take off shaft wherein the gearbox clutch is used in a continuous slipping mode.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the gearbox clutch of DE in a continuous slipping mode in view of Boll to avoid thermal overload of the clutch and electric machine.

Claims 3, 4 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over DE in view of Boll as applied to claims 1 and 22 above, and further in view of Hohn. DE in view of Boll discloses an engine starting arrangement, but does not disclose fuel/gas controlled by a controller to start the engine.

Hohn discloses a drive assembly wherein an electric machine is used to start an engine while a kickdown switched is turned on and an extreme acceleration is determined (gas pedal exceeds position, high fuel consumption) (column 2, lines 31-39).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the engine of DE in view of Boll started with a kickdown switch turned on in view of Hohn to reduce the speed output of the engine to provide smooth transformation between the electric motor drive mode to the engine drive mode.

Allowable Subject Matter

Claims 9, 10 and 16-18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

FACSIMILE TRANSMISSION

Submission of your response by facsimile transmission is encouraged. Group 3600's facsimile number is **(703) 872-9326 before final and 703-872-9327 after final**. Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase a patent's term, it is to your benefit to submit responses by facsimile transmission whenever permissible. Such submission will place the response directly in our examining group's hands and will eliminate Post Office processing and delivery time as well as the PTO's mail room processing and delivery time. For a complete list of correspondence not permitted by facsimile transmission, see MPEP 502.01. In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a deposit account, can be submitted by facsimile transmission. Responses requiring a fee which applicant is paying by check **should not be** submitting by facsimile transmission separately from the check.

Responses submitted by facsimile transmission should include a Certificate of Transmission (MPEP 512). The following is an example of the format the certification might take:

I hereby certify that this correspondence is being facsimile transmitted to
the Patent and Trademark Office (Fax No. (703) 000-0000) on _____ (Date)

Typed or printed name of person signing this certificate:

(Signature)

If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and MPEP 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response after your response has been transmitted by facsimile will only

Art Unit: 3681

cause further unnecessary delays in the processing of your application; duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

-Reinbeck ('325), Stridsberg ('002), Masterson ('371), Masberg et al ('544), Ando et al ('368), Pels et al ('180), WO 2004111441A1.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TISHA D. LEWIS whose telephone number is 571-272-7093. The examiner can normally be reached on M-Thur 6 AM TO 2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, CHARLES A. MARMOR can be reached on 571-272-7095. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 10/711,851

Page 8

Art Unit: 3681

Tdl

May 31, 2005

Tisha Lewis
TISHA LEWIS
PRIMARY EXAMINER
Art 3681 5/31/05